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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,993	06/02/1999	STEPHEN LESLIE TYLER	169.1322	9943
5514	7590	04/21/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			GHEE, ASHANTI	
			ART UNIT	PAPER NUMBER
			2626	
DATE MAILED: 04/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/323,993	TYLER, STEPHEN LESLIE
	Examiner Ashanti Ghee	Art Unit 2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 January 2004.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) \_\_\_\_\_ is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1-13 and 25-36 is/are allowed.

6) Claim(s) 37-52 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 02 June 1999 is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to the following communications: amendment C filed on 1/9/04.
2. This application has been reconsidered. Claims 1-13 and 25-52 are pending.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 37-39 and 42-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okimoto et al. (US Patent No. 6,268,926 B1) in view of Brobst et al. (US Patent No. 6,061,700).

Regarding claim 37, Okimoto discloses a method of printing a plurality of web-site documents, said method comprising the steps of: determining (determines) whether an amount (number of sheets reads on an amount) of said plurality of selected documents (number of sheets required to print reads on plurality of selected documents) exceeds (greater than) a predetermined value (predetermined number reads on predetermined value; col. 5, lines 28-48); and printing (printed) a number (number of sheets) of said plurality of selected documents (evident that operator inputs confirmation that the print data should not be reduced; therefore only a portion of the mail will be printed since it exceeds a predetermined number of sheets) up to (col. 27,

lines 50-55) a predetermined value (predetermined number reads on predetermined value), if it is determined that the amount (number of sheets reads on an amount) exceeds said predetermined value, and otherwise printing (print) each of said plurality of selected documents (print mail reads on plurality of selected documents; col. 6, lines 3-7 and col. 27, lines 51-col. 28, lines 1-6).

Although Okimoto does not specifically disclose selecting said plurality of documents from documents previously accessed by a user, Brobst discloses selecting (selected) said plurality of documents (web pages) from documents previously accessed by a user (evident that user selected reads on previously accessed documents by a user; col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 38, Okimoto does not specifically disclose a method wherein said accessed documents are accessed using a Web browser. However, Brobst discloses a method wherein said accessed documents are accessed using a Web browser (col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to

web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 39, Okimoto does not specifically disclose a method further comprising the step of prompting said user to identify particular documents desired to be printed. However, Brobst discloses a method further comprising the step of prompting said user to identify particular documents desired to be printed (col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 40, Okimoto discloses an apparatus, said apparatus comprising: determining means for determining whether an amount (number of sheets reads on an amount) of said plurality of documents (number of sheets required to print reads on plurality of selected documents) exceeds (greater than) a predetermined value (predetermined number reads on predetermined value; col. 5, lines 28-48); and printing control means for printing a number of said plurality of selected documents (evident that operator inputs confirmation that the print data should not be reduced; therefore only a portion of the mail will be printed since it exceeds a predetermined number of sheets) up to (col. 27, lines 50-55) said predetermined value (predetermined number reads on predetermined value), if it is determined that the amount (number of sheets reads on an

amount) exceeds said predetermined value, and otherwise printing (print) each of said plurality of selected documents (print mail reads on plurality of selected documents; col. 6, lines 3-7 and col. 27, lines 51-col. 28, lines 1-6).

Although Okimoto does not disclose for printing a plurality of web-site documents, Brobst discloses for printing a plurality of web-site documents (col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 41, Okimoto discloses a computer program product comprising a computer readable medium having a computer program code stored thereon, said program code controlling the computer to perform the steps of: determining (determines) whether an amount (number of sheets reads on an amount) of said plurality of selected documents (number of sheets required to print reads on plurality of selected documents) exceeds (greater than) a predetermined value (predetermined number reads on predetermined value; col. 5, lines 28-48); and printing (printed) a number (number of sheets) of said plurality of selected documents (evident that operator inputs confirmation that the print data should not be reduced; therefore only a portion of the mail will be printed since it exceeds a predetermined number of sheets) up to (col. 27, lines 50-55) a predetermined value (predetermined number reads on

predetermined value), if it is determined that the amount (number of sheets reads on an amount) exceeds said predetermined value, and otherwise printing (print) each of said plurality of selected documents (print mail reads on plurality of selected documents; col. 6, lines 3-7 and col. 27, lines 51-col. 28, lines 1-6).

Although Okimoto does not disclose for printing a plurality of web-site documents, Brobst discloses for printing a plurality of web-site documents (col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 42, Okimoto discloses a method for printing a plurality of documents automatically formatted by an application program, said method comprising the steps of: determining (determines) whether said plurality of selected documents (number of sheets required to print reads on plurality of selected documents) exceeds (greater than) a predetermined value (predetermined number reads on predetermined value; col. 5, lines 28-48), said predetermined value (prescribed number of print sheets) being determined by a provider of said application program (program reads on provider of the application program; col. 27, lines 23-40); and printing (printed) a portion of said plurality of selected documents (evident that operator inputs confirmation that the print data should not be reduced; therefore only a portion of the mail will be printed since it

exceeds a predetermined number of sheets) if it is determined that said plurality of selected documents exceeds said predetermined value (col. 6, lines 3-7 and col. 27, lines 51-col. 28, lines 1-6), otherwise printing each of said selected documents (col. 5, lines 28-48 and col. 27, lines 23-40).

Although Okimoto does not specifically disclose selecting said plurality of documents from documents previously accessed by a user via traversal of a computer network, Brobst discloses selected) said plurality of documents (web pages) from documents previously accessed by a user (evident that user selected reads on previously accessed documents by a user via traversal of a computer network;(Internet reads on computer network; col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 43, Okimoto does not disclose a method wherein said documents are web-site documents and said amount represents a number of Uniform Resource Locators. However, Brobst discloses a method wherein said documents are web-site documents (col. 5, lines 21-col. 6, lines 1-53) and said amount represents a number of Uniform Resource Locators (col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst

due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 44, Okimoto does not disclose a method wherein said accessed documents are accessed using a Web browser. However, Brobst discloses a method wherein said accessed documents are accessed using a Web browser (col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 45, Okimoto does not disclose a method further comprising the step of prompting a user to identify particular documents to be printed. However, Brobst discloses a method further comprising the step of prompting a user to identify particular documents to be printed (col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 46, Okimoto discloses an apparatus, said apparatus comprising: determining means for determining (determines) whether said plurality of selected documents (number of sheets required to print reads on plurality of selected documents) exceeds (greater than) a predetermined value (predetermined number reads on predetermined value; col. 5, lines 28-48), said predetermined value (prescribed number of print sheets) being determined by a provider of said application program (program reads on provider of the application program; col. 27, lines 23-40); and printing control means for printing (printed) a portion of said plurality of selected documents (evident that operator inputs confirmation that the print data should not be reduced; therefore only a portion of the mail will be printed since it exceeds a predetermined number of sheets) if it is determined that said plurality of selected documents exceeds said predetermined value (col. 6, lines 3-7 and col. 27, lines 51-col. 28, lines 1-6), otherwise printing each of said selected documents (col. 5, lines 28-48 and col. 27, lines 23-40).

Although Okimoto does not disclose for printing a plurality of documents previously accessed by a user via traversal of a computer network, said plurality of documents being automatically formatted by an application program, Brobst discloses for printing a plurality of documents previously accessed by a user via traversal of a computer network (col. 5, lines 21-col. 6, lines 1-53), said plurality of documents being automatically formatted by an application program (col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst

due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 47, Okimoto discloses a computer program product comprising a computer readable medium having a computer program code stored thereon, said program code controlling the computer to perform the steps of: determining (determines) whether said plurality of selected documents (number of sheets required to print reads on plurality of selected documents) exceeds (greater than) a predetermined value (predetermined number reads on predetermined value; col. 5, lines 28-48), said predetermined value (prescribed number of print sheets) being determined by a provider of said application program (program reads on provider of the application program; col. 27, lines 23-40); and printing (printed) a portion of said plurality of selected documents (evident that operator inputs confirmation that the print data should not be reduced; therefore only a portion of the mail will be printed since it exceeds a predetermined number of sheets) if it is determined that said plurality of selected documents exceeds said predetermined value (col. 6, lines 3-7 and col. 27, lines 51-col. 28, lines 1-6), otherwise printing each of said selected documents (col. 5, lines 28-48 and col. 27, lines 23-40).

Although Okimoto does not disclose for printing a plurality of documents previously accessed by a user via traversal of a computer network, said plurality of documents being automatically formatted by an application program, Brobst discloses for printing a plurality of documents previously accessed by a user via traversal of a

computer network (col. 5, lines 21-col. 6, lines 1-53), said plurality of documents being automatically formatted by an application program (col. 5, lines 21-col. 6, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 48, Okimoto does not disclose said provider is a developer and/or supplier of said application program. However, Brobst discloses a method wherein said provider is a developer and/or supplier of said application program (col. 6, lines 6-42).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 49, Okimoto does not disclose said provider is a developer and/or supplier of said application program. However, Brobst discloses an apparatus wherein said provider is a developer and/or supplier of said application program (col. 6, lines 6-42).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst

due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 50, Okimoto does not disclose said provider is a developer and/or supplier of said application program. However, Brobst discloses a computer program wherein said provider is a developer and/or supplier of said application program (col. 6, lines 6-42).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 51, Okimoto discloses an apparatus wherein said determining means for determining whether an amount (number of sheets reads on an amount) of said plurality of documents (number of sheets required to print reads on plurality of selected documents) exceeds (greater than) a predetermined value (predetermined number reads on predetermined value; col. 5, lines 28-48) and exceeds a predetermined value (col. 5, lines 28-48).

Although Okimoto does not disclose when a number of pages specified by said provider of said application program exceeds the predetermined value, Brobst discloses when a number of pages specified by said provider of said application program or a

number of URLs specified by said provider of said application program (col. 6, lines 5-col. 7, lines 1-60).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

Regarding claim 52, Okimoto does not disclose said provider is a developer and/or supplier of said application program. However, Brobst discloses an apparatus wherein said provider is a developer and/or supplier of said application program (col. 6, lines 6-42).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Okimoto and Brobst due to both references disclosing internet printing systems to provide improvements to web users without the users having to manually invoke and print each of 40 related web pages that the user needs.

#### ***Allowable Subject Matter***

5. Claims 1-13 and 25-36 are allowable over the prior art of record.
6. The following is an examiner's statement of reasons for allowance: Claims 1-13 and 25-36 are allowable over the prior art of record because the Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of the said prior art which teaches a method, apparatus, and program that

manipulates electronic documents created by an application that comprises identifying user-invoked manipulations of an electronic document, determining if the manipulations is part of a predetermined group of manipulations, if the manipulations is not a part of the predetermined group then the manipulations are allowed to proceed, if the manipulations are a part of the predetermined group then only a predetermined portion of the electronic document may be allowed to proceed, wherein the predetermined portion is defined by a provider of an application program; selecting a plurality of documents from documents already accessed by a user; determining if the selected documents exceeds a predetermined value; and printing only a portion of the selected documents if it is determined if the selected documents exceeds the predetermined value, respectively, as set forth in Claims 1, 13, and 25 including all of the features recited therein.

***Response to Arguments***

7. Applicant's arguments filed 1/9/04 have been fully considered but they are not persuasive.

Applicant argues that Okimoto fails to disclose or suggest that the feature of printing a number of pages up to a predetermined value, if it is determined that the amount of selected documents exceeds the predetermined value, otherwise printing each of the selected documents (found on pages 12 and 13 of the amendment).

The Examiner does not agree with this argument due to Okimoto disclosing the determination of a number of sheets which clearly reads on the amount of a plurality of selected documents (see col. 5, lines 28-48 and col. 27, lines 23-col. 28, lines 1-6) and

up to a predetermined value (prescribed number of sheets reads on predetermined value; see col. 27, lines 23-col. 28, lines 1-6). Okimoto also discloses that the determination exceeds (greater than) the predetermined value (see col. 27, lines 23-col. 28, lines 1-6). As for the otherwise printing each of said selected documents, it is obvious in the Okimoto reference that since there is a predetermined number of sheets, then the amount of selected documents could only be printed out on the number of sheets that the printer has (see col. 27, lines 23-col. 28, lines 1-6 and col. 35, lines 46-52).

Therefore, previous rejection stands.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

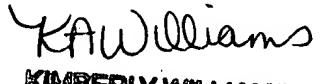
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashanti Ghee whose telephone number is (703) 306-3443. The examiner can normally be reached on Mon-Thurs and alt. Fri. (7-4PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ashanti Ghee  
Examiner  
Art Unit 2626

  
AG  
April 18, 2004

  
KAW  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER